

REMARKS

This is a full and timely response to the non-final Official Action mailed **October 14, 2004**. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, various claims have been amended. No claims are added or cancelled. Claims 22-30 were withdrawn from consideration under a previous Restriction Requirement. Thus, claims 1-21 and 31-43 are currently pending for the Examiner's consideration.

In the outstanding Office Action, the Examiner indicated the presence of allowable subject matter in claims 4, 5, 12-14 and 33. Applicant wishes to thank the Examiner for this indication of allowable subject matter.

Consequently, claims 4, 12, 13 and 33 have been amended herein and rewritten as independent claims. Therefore, based on the Examiner's identification of allowable subject matter, claims 4, 5, 12-14 and 33 should be in condition for allowance following entry of this amendment. Notice to this effect is respectfully requested.

Next, the Office Action rejected claims 2, 16, 17, 34, 35, 37-39 and 41-43 under 35 U.S.C. § 112, second paragraph. These claims have been carefully reviewed in light of the Examiner's comments and amended to clarify the claim language. These amendments do not, and are not intended to, narrow or alter the scope of the affected claims.

Following entry of this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112. Notice to that effect is respectfully requested.

With respect to the prior art, claims 1, 3, 6-9, 11, 15, 31, 32 and 36 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 3,087,364 to Witmer (“Witmer”).

For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites:

An adjustable socket comprising:
a driver rotatable around a longitudinal axis and having a first end;
a polygonal recess disposed in said first end of said driver;
a second recess adjacent said polygonal recess; and
a stopper disposed in said second recess, said stopper being adjustable so as to extend from said second recess at any of a range of different distances into said polygonal recess.
(emphasis added).

In contrast, Witmer fails to teach or suggest a stopper that is adjustable so as to extend from a second recess at any of a range of different distances into a (first) polygonal recess, as claimed. Rather, Witmer merely teaches a “remover tool 30” that sits inside a socket 14 to help with the removal of a nut or bolt with edges that are worn and difficult for the socket alone to rotate. The Witmer “remover tool” is not adjustable so as to extend at any of a range of different distances into a recess of a socket driver as claimed. The Witmer “remover tool” is not “adjustable” in any meaningful way.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least this reason, the rejection of claims 1, 3, 6-10 and 40 based on Witmer should be reconsidered and withdrawn.

Claim 11 similarly recites:

An adjustable socket operative to rotatably drive a fastener comprising:
a first recess disposed in said socket receptive of said fastener; and
an adjustable stopper disposed in a second recess of said adjustable socket for
limiting penetration of said fastener into said first recess;
wherein said stopper is adjustable so as to extend into said first recess from
said second recess at any of a plurality of different distances for selectively limiting
penetration of said fastener into said first recess.

(emphasis added).

As demonstrated above, Witmer fails to teach or suggest a stopper that is adjustable so as to extend into a first recess from a second recess at any of a plurality of different distances for selectively limiting penetration of a fastener into that first recess. Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least this reason, the rejection of claims 11 and 15 based on Witmer should be reconsidered and withdrawn.

Claim 31 recites:

An adjustable socket operative to rotatably drive a fastener comprising:
engagement means for engaging said fastener; and
stopper means for limiting penetration of said fastener into said engagement
means;
wherein said stopper means are adjustable so as to selectively limit penetration
of said fastener into said engagement means to any of a plurality of different distances.
(emphasis added).

As demonstrated above, Witmer fails to teach or suggest the claimed stopper means that are adjustable so as to selectively limit penetration of a fastener into an engagement means to any of a plurality of different distances. Witmer simply fails to teach or suggest any

element that is adjustable to allow selective penetration of a fastener into an engagement means over a plurality of different distances.

Claims 31 and 36 were also rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 6,779,423 to Hammons et al. (“Hammons”). Hammons, however, also fails to teach or suggest the recited stopper means that are adjustable as claimed.

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least this reason, the rejection of claims 31, 32 and 36 based on Witmer, or alternatively on Hammons, should be reconsidered and withdrawn.

Next, claims 18-21 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,471,160 to Sabo (“Sabo”). For at least the following reasons, this rejection is respectfully traversed.

Claim 18 recites: “A method of tightening or loosening a fastener without damaging a work piece secured with said fastener, said method comprising adjusting a stopper disposed within a socket driver to control an extent to which said fastener is engaged by said driver.”

In contrast, Sabo does not teach or suggest the claimed method. Sabo teaches a method of turning or torquing a pipe (30) without applying a pipe wrench to the exterior of the pipe (30). A section of pipe (32) is screwed onto the threads (43) of the pipe (30) to be turned. A frusto-conical engagement member (20) is then secured in the section of pipe (32) by a plug (44). A pipe wrench (31) is then applied to the section of pipe (32) rather than to the pipe (30) to be turned.

Sabo does not teach or suggest adjusting a stopper disposed in a socket driver to control an extent to which a fastener is engaged by the driver. There is no discussion in Sabo of controlling the extent to which a fastener is engaged by a driver. Moreover, there is no discussion or suggestion of controlling the engagement of a fastener by adjusting a stopper. Sabo simply does not teach or suggest any of the features of claim 18.

Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least this reason, the rejection of claims 18-21 based on Sabo should be reconsidered and withdrawn.

Lastly, claims 10 and 40 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the teachings of Witmer taken alone. For at least the following reasons, this rejection is respectfully traversed.

Claims 10 and 40 are believed to be patentable over the prior art of record for at least the same reasons as given above with respect to claim 1, from which claims 10 and 40 both depend. Consequently, for at least the reasons given above with respect to claim 1, the rejection of claims 10 and 40 should be reconsidered and withdrawn.

Moreover, even though the prior art does not show the features of claims 10 and 40, the Office Action alleges that such features would have been obvious. This is insufficient as a matter of law.

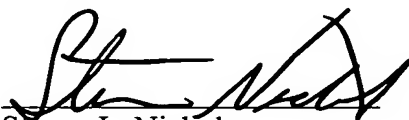
Where the Office relies on a single reference under § 103, it is insufficient to merely state that it would be obvious, or a mere matter of design choice, to modify the disclosure to

include the features of the claimed invention. *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). Accord. M.P.E.P. § 706.02(j). For at least this additional reason, the rejection of claims 10 and 40 should be reconsidered and withdrawn.

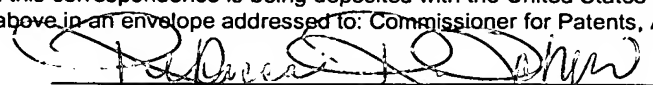
For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 16 December 2004


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DATE OF DEPOSIT: <u>December 16, 2004</u>	
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